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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,641	11/17/2000	Robert D. Haskins	ZIP00-01	7793

58406 7590 11/25/2008

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EXAMINER	
DENNISON, JERRY B	
ART UNIT	PAPER NUMBER
2443	

MAIL DATE	DELIVERY MODE
11/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/715,641	HASKINS ET AL.	
	Examiner	Art Unit	
	J. Bret Dennison	2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 18-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16, and 18-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. This Action is in response to the Amendment for Application Number 09/715,641 received on 09/04/2008.

2. Claims 1-16, and 18-31 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-16 and 18-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al. (U.S. 2003/0233420) in view of Barchi (U.S. 6,507,866).

4. Regarding claims 1, 2, 12, 14, 15, and 26-29, Stark disclosed a method for controlling transmission of messages from an originator computer system through an originating mail server, the method comprising the steps of:

dynamically creating a valid account name and network address pair (Stark, [0048], Stark disclosed the MessageML Service Provider using SMTP email account and physical IP address, as well as domain from the message in order to validate the sender; As such the provider creates a valid account name and address pair, for which it uses to look up to verify the sender);

detecting an outbound message from an originator computer system (Stark, [0048], Stark disclosed a MessageML Service detecting an outbound message from a sender); and

verifying an authenticity of an originator identity associated with the outbound message by comparing a mapping of network addresses with account names such that the originator identity associated with the outbound message is associated with a valid account name and network address pair (Stark [0048], Stark disclosed when the MessageML Service receives a message from a sender, the Service Provider checks the physical IP address and the account to verify that the IP address matches one of the entries in the Informant Stylesheet, and if a match is found, the message is considered authentic, otherwise, rejected; [0047] The Informant Stylesheet defines information about the Informant or sender of the information and its valid transport sources or locations from where it will send its messages, i.e. identity of originator).

Stark did not explicitly state performing a quota enforcement operation based on a message count and a message limit associated with an originator identity to produce a message transmission result; and

performing a selective transmit operation including at least one of:

i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value

In an analogous art, Barchi disclosed tracking the originator of email messages

with a field containing information identifying the originator of the received email message (Barchi, col. 8, lines 1-8);

performing a quota enforcement operation based on a message count associated with an originator and a message limit to produce a message transmission result (Barchi, col. 6, lines 43-48, Fig. 5, 503-505, Barchi disclosed checking the message count against a threshold; col. 5, lines 59-63, Barchi disclosed detecting from a single user); and

performing a selective transmit operation including at least one of

i) transmitting the outbound message from an originating mail server onto a computer network if the message transmission result contains a transmit value; and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value (Barchi, col. 8, lines 10-32, Barchi disclosed setting a flag depending on whether the threshold has been exceeded, the flag being used to determine whether to prevent or allow transmission of the message).

The purpose for authenticating the sender of an email message in Starks is to prevent the use of the email system by malicious users. The purpose for the email usage pattern detection teachings of Barchi is to prevent malicious users from sending massive quantities of undesired email. Since both references teach acts of preventing unauthorized, malicious use of email systems (Starks, [0047]; Barchi, col. 3, lines 65-67), it would have been obvious for one of ordinary skill in the at the time the invention

was made to incorporate the email usage detection teachings of Barchi into the teachings of Starks in order to make sure that once a user's email is authenticated as coming from an original identity, that the user is not sending out massive amounts of undesired email, i.e. spam, for the benefit of providing extra protection against users abusing the email system, in order to reduce or eliminate the volume of undesired email messages received by a computer system or server (Barchi, col. 1, lines 10-13).

Claims 12 includes a method with limitations that are substantially similar to the limitations of claim 1. Claims 14 and 26 include a computer system (Barchi, Fig. 9) with a database (Barchi, col. 6, lines 20-55) used to perform the limitations of claim 1. Claims 27 and 28 include a computer program product with limitations substantially similar to claim 1. Claim 29 includes a method with limitations that are substantially similar to the limitations of claim 1. Therefore, claims 12, 14, 26, 27 and 28-29 are rejected under the same rationale.

5. Regarding claims 3 and 16, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (Stark, [0048]);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (Stark, [0048]);

and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (Barchi, col. 6, lines 38-50).

6. Regarding claims 4 and 17, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 3 and 16, including wherein:

the step of obtaining an originator address includes retrieving a network address associated with the outbound message from a message connection establishment protocol used to transfer the outbound message from an originator computer system to a recipient computer system (Barchi, col. 8, lines 1-8);

the step of obtaining the originator identity includes the step of querying a login database containing mappings of originator addresses to originator identities based on the originator address obtained in the step of obtaining an originator address (Stark, [0048]); and the

step of obtaining a message count for the originator identity associated with the outbound message includes querying a quota database containing associations of message counts to originator identities based on the originator identity associated with the outbound message (Barchi, col. 6, lines 38-50); and

wherein the message count is at least one message count that indicates, for an originator identity, a current number of outbound message transmitted over an elapsed time interval (Barchi, col. 6, lines 38-50, col. 7, line 65 through col. 8, line 10); and

wherein the message limit is at least one message limit corresponding to a

respective at least one message count that indicates, for an originator identity, a maximum number of outbound messages that may be transmitted over a predetermine time interval (Barchi, col. 7, line 65 through col. 8, line 10). See above for motivation.

7. Regarding claims 5 and 18, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the step of updating the message count associated with the originator identity of the outbound message includes the steps of calculating a total number of recipients for the outbound message and incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (Barchi, col. 8, lines 1-45, Barchi discloses tracking recipients of email messages). See above for motivation.

8. Regarding claims 6 and 19, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the message limit indicates an amount of outbound messages that may be transmitted from the originator computer system over a certain period of time for the originator identity associated with the outbound message (Barchi, col. 8, lines 1-10, Barchi discloses a threshold for a period of time); and

wherein the originator identity of the outbound message is indicative of at least one of:

a specific user account operating under control of a computer user;

a specific message sending user; and

a specific domain (Stark, [0048]).

9. Regarding claims 7 and 20, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein:

the message limit condition indicates if a computer user account associated with the originator identity used to transmit the outbound message is attempting to transmit a number of outbound messages that exceeds the message limit in a predetermined amount of time (Barchi, col. 7, line 65 through col. 8, line 8); and

wherein the message limit condition occurs if the step of comparing determines at least one of the message count exceeds the message limit(Barchi, col. 7, line 65 through col. 8, line 8); and

the message count is equal to the message limit (Barchi, col. 7, line 65 through col. 8, line 8) See above for motivation.

10. Regarding claims 8 and 21, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 2 and 15, including wherein the quota enforcement operation includes the steps of:

verifying authenticity of at least one recipient associated with outbound message (Barchi, col. 8, lines 1-50). See above for motivation.

11. Regarding claims 9 and 22, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 1 and 14, including wherein the step of performing a quota enforcement operation includes the step of:

comparing a previous message transmission result with a no-transmit value, and if the previous message transmission decision equals the no-transmit value, performing the step of performing a selective transmit operation (Barchi, col. 8, lines 1-45). See above for motivation.

12. Regarding claims 10 and 23, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claims 1 and 14, including wherein the step of detecting an outbound message includes the steps of:

searching a quota enforcement list for an originator address associated with the message, and if the originator address associated with the message is contained in the quota enforcement list, performing the steps of performing a quota enforcement operation and performing a selective transmit operation, and if the originator address associated with the message is not contained in the quota enforcement list, skipping the step of performing the quota enforcement operation and performing the step of transmitting the outbound message from the computer system (Barchi, col. 8, lines 1-45). See above for motivation.

13. Regarding claims 11 and 24, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 1, including the steps of:

authenticating a connection from the originator computer system (Stark [0048],);

recording authentication information in a login database, the authentication information including an originator address assigned to the originator computer system and an originator identity associated with the originator address (Stark [0047]-[0048],);

receiving, for transmission to a recipient computer system, the outbound message from the originator computer system (Stark [0048],);

forwarding the outbound message to a quota server to perform the steps of detecting an outbound message, performing a quota enforcement operation and performing a selective transmit operation (Barchi, col. 8, lines 1-45). See above for motivation.

14. Regarding claim 13, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 12, including wherein:

the at least one message count includes a first message count and a second message count (Barchi, col. 8, lines 1-45);

wherein the at least one message limit includes a first message limit and a second message limit(Barchi, col. 8, lines 1-45);

wherein in the step of comparing, the first message count is compared to the first message limit to determine if the first message count exceeds the first message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45); and

wherein in the step of comparing, the second message count is compared to the second message limit to determine if the second message count exceeds the second message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45).

15. Regarding claim 25, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 24, including wherein the port redirector is a data communications device capable of directing outbound messages based on content contained within the outbound message, and wherein when the port redirector receives an outbound message that is to be subject to message quota enforcement based upon content contained with the outbound message, the port redirector forwards the outbound message to the quota server (Barchi, col. 8, lines 1-45). See above for motivation.

16. Regarding claim 30, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 29, including

buffering, for later transmission onto a computer network, a number of copies of the outbound message equal to a difference between a total number of recipients for the outbound message and the number of recipients to which the outbound message is transmitted (Barchi, col. 4, lines 56-67, Barchi disclosed receiving email messages and analyzing fields of the email messages, thereby requiring buffering such messages); and

incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (Barchi, col. 5, lines 1-10).

17. Regarding claim 31, Stark and Barchi disclosed the limitations, substantially as claimed, as described in claim 29, including incrementing the message count

associated with the originator identity by the number of recipients to which the outbound message was transmitted (Barchi, col. 4, lines 60-67).

Stark and Barchi did not explicitly state discarding any copies of the outbound message not transmitted onto a computer network to a recipient.

However, Barchi clearly suggests using the features of the invention to reduce or eliminate the volume of undesired email messages received by a server (col. 1, lines 10-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include as one of the Alarm modes of Barchi the discarding of email messages that exceed the threshold for the sender in order to successfully reduce or eliminate the volume of undesired email messages (col. 1, lines 10-13).

Response to Arguments

Applicant's arguments filed 8/18/2008 have been fully considered but they are not fully persuasive.

Applicant asserts that the prior art references discuss matters on the receiving end, whereas Applicant's invention is performed on the sender's end, and that such provides a distinction over the prior art.

Examiner respectfully disagrees for the following reasons.

1) A close review of claim 1, as well as the other independent claims, show that Applicant's claims are still not limited to the "originating mail server" as this limitation is in only one of the possible two operations that may be performed (i.e. "at

least one of"). As such, a close interpretation of the claim 1 as well as all of the other independent claims shows that the limitations are not limited to the sender side.

Therefore, while Applicant argues the prior art failing to teach such functionality at the sender side, it is clearly evident that Applicant's claimed invention also does not positively teach this functionality at the sender side. As such, Applicant's arguments regarding this matter are not persuasive.

2) For argument sake, Examiner would like to point out that even if the claims were limited to the "originator mail server," Applicant still would need to overcome that fact that it is well known in the art that a user may send another user an email wherein both users are under the same ISP. In this instance, this same ISP is both the source email server and the destination email server.

Applicant attempts to argue whether Stark is enabling or not, and that "Stark does not teach nor suggest dynamically creating a valid account name and network address pair."

In response, Examiner points out that Stark clearly points out the purpose of the physical IP address is to verify the authenticity of the sender of the message (Stark, [0048]). This paragraph clearly states that the provider checks the physical IP address, domain, or SMTP email account from which the message was received.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in order to make sure that once a user's email is authenticated as coming from an original identity, that the user is not sending out massive amounts of undesired email, i.e. spam, for the benefit of providing extra protection against users abusing the email system, in order to reduce or eliminate the volume of undesired email messages received by a computer system or server (Barchi, col. 1, lines 10-13).

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. Bret Dennison/
Examiner, Art Unit 2443